

REMARKS

1. Final Rejection, Premature

The finality of the December 8, 2003, Office Action was improper, and Applicant respectfully requests reconsideration as a non-final Office Action.

According to MPEP §707.07(a), "second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims, nor based on information submitted in an information disclosure statement. . . ." (emphasis added by author). In the Office Action dated December 8, 2003 it is admitted that the grounds of rejection are new. See Final Office Action dated December 8, 2003, p. 5, no. 6. However, the Office Action was made final based on a belief that the previous amendments necessitated the new grounds for rejection. Applicant respectfully disagrees.

According to the Final Office Action, Lang discloses all of the features of claims 1, 7, 8 and 13 except an appliqué element mounted on a translucent base and extending to cover a halo section. Examiner cites new art reference, Furey (which was not cited in Applicant's IDS), as teaching the appliqué element. It reasonably follows that it is the appliqué element of claims 1, 7, 8 and 13 that necessitated the citation of the newly cited reference, Furey, and the grounds for rejection based thereon. However, the previous amendment did not add or modify the appliqué element. Rather, this feature is present in its original form in the currently pending claims. Consequently, Applicant believes that the previous amendment could not have necessitated the citation of Furey and the new grounds for rejection based thereon.

In addition, a closer look at the previous amendment of claims 1, 8 and 14-16 reveals that such amendments were made only for purposes of improving form and clarity. The amendments do not add any new features or limitations that would lead Examiner to rely on new grounds and new art.

For instance, claim 1 was amended to add to the preamble the light source and its relationship with the knob assembly. As noted by the Examiner, however, this matter does not constitute a limitation of the claims and, therefore, was not given any patentable weight. Consequently, this particular amendment to claim 1 could not have necessitated the Examiner's new grounds for rejection.

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The remaining amendments to claim 1 pertain to the halo section. As originally claimed, the halo section is located on the lower portion of the outer surface of the translucent base. The language of claim 1 was previously amended to more directly point out that the halo section is defined on the base. However, this relationship between the halo section and the base was included in the claim originally, but using less direct language. Since this amendment does not add any substantive matter to the claim, it could not have necessitated Examiner's new grounds for rejection. Claim 1 was also previously amended to specify that the halo section is "translucent." However, it appears that this feature is not what necessitated Examiner's reliance on Lang and Furey. Rather, as noted above, Examiner relies on newly cited reference, Furey, for the appliqué element which has not been amended and is still in its original form.

The previous amendments to claims 8 and 14-16 were also made simply to clarify the language in the claims. These amendments do not add any substantive material or new features to the claims and, therefore, could not have necessitated Examiner's reliance on new grounds based on newly cited art.

For all the reasons set forth above, Applicant believes that the designation of the December 8, 2003 Office Action as final was premature and improper. Applicant respectfully requests reconsideration and withdrawal of the finality of the rejection, entry of the amendments herein, and consideration of the amended claims and remarks submitted herein.

2. Amendments.

The present application includes claims 1-5, 7-11, and 13-16 pending and under consideration. Claim 7 has been amended to more clearly set forth the relationship between the halo section and the mounting panel.

3. Rejections under 35 U.S.C. §112.

Claims 1 and 8 were rejected under 35 U.S.C. §112 as being based on a disclosure that is not enabling. In particular, Examiner has asserted that a light source is critical or essential to the practice of the invention and, therefore, must be positively claimed. Applicant respectfully disagrees. The present invention, as claimed in claims 1-5, 7-11 and 13, pertains to an indicator knob that may be mounted over a portion of a mounting panel. The mounting panel may be mounted over a light source, which provides back lighting of the portion of the mounting panel.

Indeed, it is possible for the knob assembly of the present invention to be manufactured and/or sold as a package along with the mounting panel and light source. In practice, however, it is likely that the knob assembly will be manufactured separately without the mounting panel and light source. The knob assembly will then be sold alone or together with the mounting panel. For instance, a buyer, such as an automobile manufacturer, may purchase the knob assembly separately and install the knob assembly over a mounting panel or dash board, which will be or already has been mounted over a light source. Alternatively, a buyer, such as a vehicle component manufacturer, may purchase the knob assembly separately and use it along with a mounting panel, light source, and other parts to assemble and produce an automobile component, such as a stereo, an instrument panel, or climate control system. The vehicle component manufacturer may then sell the component as a package to a vehicle manufacturer or repair shop. These examples demonstrate that the knob assembly of the present invention may be practiced, that is manufactured, sold and used, without the light source and, therefore, the light source is not essential to the practice of the invention.

As noted above, the knob assembly may be manufactured and sold as a packaged component along with the mounting panel and light source. Even in this case, a market exists for replacement knob assemblies. For instance, it is possible for the knob assemblies to break or become damaged if misused or mishandled. Consequently, a manufacturer may practice the present invention by manufacturing and selling the knob assemblies of the present invention separately without a mounting panel and/or a light source. These knob assemblies would then be used to replace damaged or faulty knob assemblies. This provides yet another example of how one might practice the invention without the light source.

As demonstrated by these examples, Applicant believes that the knob assemblies of the present invention may be practiced (that is, made, used and/or sold) without the light source and, therefore, is an invention all its own. Accordingly, Applicant believes that the light source is not critical or essential to the practice of the invention and that it need not be positively claimed. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §112.

4. Claim Rejections Under 35 U.S.C. §103.

Claims 1, 2, 7, 8 and 13-16 were rejected under 35 U.S.C. §103 as unpatentable over Lang (U.S. Patent No. 4,549,050) in view of Furey (U.S. Patent No. 3,074,372). More

specifically, it was determined that Lang discloses all of the features of claims 1, 2, 7, 8 and 13-16 except an appliqué element mounted on a translucent base, while Furey discloses an appliqué element.

First, Applicant respectfully disagrees with the conclusion that Lang discloses all of the features of claims 1, 2, 7, 8 and 13-16, except the appliqué element. Claims 1, 2, 7, 8 and 13-16 call for a base 26 having an upper portion 22 and a lower (bottom) portion 24 and defining a translucent halo section 40 on the lower (bottom) portion 24 of the base 26. As described in paragraph 20 of the specification, when the knob is backlit, light passes through and emits from the halo section to illuminate the lower (bottom) portion 24 of base 26. As further described in paragraph 20, the lower (bottom) portion 24 of the base 26 is positioned adjacent the mounting panel 42 and, therefore, illumination of the lower (bottom) portion of the knob enables the illumination of any markings on the adjacent mounting panel 42.

Lang discloses a control knob including a translucent member 28 and an opaque member 30 which are threadably interconnected. See Col. 2, lines 39-41; Col. 3, lines 1-2 and Fig. 2. The translucent member 28 defines an inner (lower) end and an outer (upper) end. The upper end defines an enlarged circular head, while the lower end defines an opening 32 and an externally threaded tapered portion. The externally threaded tapered portion is threadably inserted into threaded opening 32 of opaque member 30. Col. 2, lines 44-51. The entire inner and outer surfaces of translucent member 28 are covered with shielding means 42, 44, respectively, except for tapered surface 36 at lower end and rim portion 34 of the enlarged head. Shielding means 42, 44 prevent light from passing through translucent member 28. Col. 2, lines 48-62. Although, tapered surface 36 at lower end of member 28 is not covered by shielding means 42, the unshielded tapered portion 36 of the lower end is inserted into opening 32 of opaque member 30 and, therefore, the lower end is covered by opaque member 30. Thus, opaque member 30 prevents light from passing through and emitting from the unshielded tapered portion of the lower end. Fig. 2. This is further supported by the description in Lang which states,

"As seen in Fig. 2, when the light bulb 54 is lighted, the light rays therefrom will enter the inner end of the member 28 at the tapered surface 36 thereof and travel axially therethrough and then bend 90° at the enlarged head of the member 28 and be emitted radially

and also axially forwardly from the rim portion 34. The lighting of light bulb 54 will create somewhat of a halo effect around the enlarged head of the member 28 and serve to outline the latter and facilitate location of the control knob 22 in the dark." Col. 4, lines 8-18.

Light is only emitted from the rim portion 34 of the enlarged head defined in the upper end portion of the translucent member 28, thereby creating a halo effect only at the upper end portion, not at the lower end portion of the knob. As further stated in Description,

"It will be understood that the shielding means 42 and 44 on the inner and outer surfaces of the member as well as the socket 50 which closes the inner end of the opening 32, will assure that the light rays emitted by the light bulb 54 will travel only through the member 28 as explained above . . ." Col. 4, lines 18-23.

Lang does not disclose a halo section in the lower portion of the base that is capable of emitting light and illuminating the lower portion of the base when the knob is backlit. In fact, Lang teaches away from incorporating a halo section in the lower portion of translucent member 28 by stressing that light will be emitted only from the rim portion defined in the enlarged head of the upper portion.

Accordingly, Lang does not disclose all of the features of claims 1, 2, 7, 8 and 13-16 except the appliqué element as asserted in the office action. Neither Lang nor Furey disclose a translucent base defining a halo section on the lower portion of the base as required by the claims.

In addition, claims 7 and 13 call for a mounting panel wherein the halo section of the base is positioned adjacent the mounting panel such that the light emitted from the halo section illuminates a portion of the mounting panel. In contrast, in Lang the halo effect created by the illuminating rim portion 34 is not adjacent panel 12 and is not practically capable of illuminating panel 12.

Furthermore, both Lang and Furey teach knob assemblies that require a light source (light bulbs 48, 54 in Lang and light bulbs 62, 64 in Furey) located inside the knob. In contrast, the knob assemblies of the present invention are adapted to cooperate with backlighting located behind the mounting panel, and, therefore, do not require light source within the knob itself.

For all of the reasons stated above, Applicant believes that a combination of Lang and Furey does not disclose, teach or suggest a knob assembly having all of the features set forth in claims 1, 2, 7, 8, and 13-16. Accordingly, Applicant believes that these claims are patentable over Lang and Furey. Since claims 3-5 and 9-11 depend from and include all of the limitations of one or more of claims 1, 2, 7 and 8, it is believed that these claims are also patentable over Lang and Furey. Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §103.

CONCLUSION

Applicant believes that the application, as amended, is now in allowable form and action toward that end is respectfully requested. If any issues remain that can be resolved by telephone, Examiner Courson is invited to call the undersigned attorney at (317) 237-1130.

In the event that Applicant has overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully Submitted,

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